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09/783,796	02/12/2001	Robert Sesek	10003563-1	3420

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EXAMINER	
LEE, CHEUKFAN	

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/783,796	SESEK ET AL.	
	Examiner	Art Unit	
	Cheukfan Lee	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *11-13* is/are allowed.

6)☒ Claim(s) *1,3-6,10,14,15,17,18 and 22-24* is/are rejected.

7)☒ Claim(s) *2, 7-9, 16, and 19-21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 1-24 are pending. Claims 1, 11, 14, 17 and 24 are independent.

2. Applicant's arguments with respect to claims 1, 3-6, 14, 15, 17, 18, 22, and 23 have been considered but are moot in view of the new ground(s) of rejection.

3. Claims 7, 8, 16, 19-21, and 24 are objected to because of the following:

In claim 7, line 1, "each slidable members" is not grammatical. Please note that "(Original)" is used to describe the version of claim 7 filed March 22, 2004, but the version of claim 7 presented in the amendment filed March 22, 2004 is not the "original" version.

Claim 8 is objected to as being dependent upon objected claim 7.

In claims 16 and 19, "The method as defined in claim 15 wherein prior to said determining step further comprising" and "The method as defined in claim 18 wherein prior to said determining step further comprising" are not grammatical.

Claims 20 and 21 are objected to as being dependent upon objected claim 19.

In claim 24, lines 3-4, "said method comprising the steps of" is improper. The claim is an apparatus claim, not a method claim. Further, the "means for scanning the scanable portion" and the "means for scanning said entire scanable surface" are believed to be the same means. It looks like claim 24 is written by rewriting the method claim 14 into an apparatus claim. However, the last two steps of claim 14 are proper, but the last two "means" in claim 24 are not since the two "means" are the same thing.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 3-6, 10, 14, 15, 17, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurata et al. (U.S. Patent No. 4,518,999).

Regarding claim 1, Kurata et al. discloses an apparatus comprising a (first) set of slidable cursors (23 and 24) slidably moved in the Y-direction (defined to be the main scanning direction) for defining positions (coordinates) of a scan area along the Y-direction. The X-direction is defined to be the subscanning direction of the apparatus in which the image reading unit (29) is moved during scanning. The set of slidable cursors are located on an axis that is parallel to the Y-direction. The set of cursors generate signals indicative of the coordinates corresponding to the first set. Note that the electronic circuit section (Fig. 5) generates signals or positional data (47, 61, etc.) with respect to the starting point and end point in the Y-direction (col. 3, line 39 – col. 4, line 47).

Further, a control interface is inherent in the electronic circuit section (Fig. 5) that initiates and controls a scan operation responsive to a scan signal received (from start button, col. 4, line 1+). The coordinate indicating signals (positional data) are communicated to the inherent control interface (col. 4, lines 1-61).

With respect to the claimed second set of slidable members, the feature about the "another mechanism" for the X-direction described in paragraph of Kurata et al. at

col. 4, lines 48-54 does not seem to meet the claimed second set of slidable members, although the "displacing of the reading unit 29 in the X-direction is initiated so that the reading of original document from a part designated with respect to this direction by another mechanism is performed." However, the idea of designating a reading range in both the X and Y directions using cursors movable in the X and Y direction is not novel and is taught by Kurata et al. in background of the invention (col. 1, lines 23-64, Fig. 1). The set of cursors (3 and 4) movable along the axis in the X-direction corresponds to the claimed second set of slidable members. One of ordinary skill in the art would have realized that advantage of employing two sets, the first set and second set, of slidable members or cursors over using only one set, which is to permit the user designate reading ranges in both the main scanning and subscanning direction. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the apparatus of Kurata et al. with a second set of slidable cursors or members as taught by the background (prior art) of Kurata et al. in order to allow designating of a reading range in the X or subscanning direction.

Regarding claims 3 and 4, according to Fig. 3 of Kurata et al., the first set of cursors (slidable in the Y-direction or main scanning direction) comprises two cursors that are located and retained in a first recess (Figs. 3 and 4) extending along the Y-direction or Y-axis. The two cursors are independently slidable. The positional difference between the two cursors is one dimension of the scan area. Based on the reasons of obviousness given above for claim 1 with respect to the second set of slidable members, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to also provide a second recess to retain the second set of cursors or members, the second recess extending along the X-direction or subscanning direction so that the second cursors are properly located in the apparatus. Please note that the second cursors are also independently slidable in the X-direction, and it would have been obvious to one of ordinary skill in the art that the positional difference between these two cursors is a dimension of the scan area in the X-direction.

Regarding claim 5, the claimed feature is taught be Kurata et al. According to Fig. 4, the cursors (23 and 24) comprise a relatively flat bar that extends from its respective recess a substantial distance onto the scanable surface of document glass (21 in fig. 4) to enable a user to closely identify the location of the coordinate or position being defined.

Regarding claim 6, the claimed claims "a pointer". The cursor (23 or 24) having a pointing or protruding portion (23B or 24B) reads on the claimed "pointer".

Regarding claim 10, the start button (not shown) of Kurata et al. (col. 4, line 4) reads on the claimed switch.

Regarding claim 14, the claim has been amended such that the scan area includes "at least two X coordinates and at least two Y coordinates". A method corresponding to the obvious apparatus of Kurata et al. discussed for claim 1 meets all claim limitations. Note that the defined scan area of the obvious apparatus of Kurata et al. has two X coordinates and two Y coordinates, and the controller inherently determines whether the defined scan area is the entire scan area or just a portion of the entire scan area and controls the scanning depending on the result of determination.

Regarding claim 17, the claim has been amended such that the scan area includes "a plurality of X and Y coordinates". A method corresponding to the obvious system of Kurata et al. discussed for claim 1 meets all claim limitations. Note that the plurality of cursors (which include cursors 23 and 24 arranged along the Y axis and the obvious cursors arranged along the X axis) constituting a positioning apparatus for defining a plurality of X and Y coordinates of the scan area reads on the claimed positioning apparatus having a plurality of member for defining a plurality of X and Y coordinates of the scan area.

Regarding claims 15 and 18, in Kurata et al., turning off the apparatus disables such functionality as claimed, and turning on the apparatus enables such functionality.

For claim 23, see discussion for claim 14, for claim 23 reciting limitations similar to those of claim 14.

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurata et al. (U.S. Patent No. 4,518,999) in view of well known art.

Regarding claim 22, Kurata et al. discussed for claim 17 above does not specifically disclose sending a constructed digital file of the scan area to a previously specified destination. However, Kurata et al. in the background of the invention section states "The present invention relates to a picture image position setting apparatus useful in ... picture transmitting or in electronic editing." The examiner took Official Notice of the fact that creating a digital file using a scanned image, be it the whole image or a partial image, and sending the file to a previously specified destination is

well known in the art. Since the invention of Kurata et al. is related to image transmitting, it is well known to send data in a digital file form. It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct a digital file of the scan area of Kurata et al. and send the digital file to a pre-specified destination as is well known in the art to enable remote processing or viewing of the file.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Kurata et al. (U.S. Patent No. 4,518,999).

Claim 24 has not been amended in the amendment filed March 22, 2004 to include limitation(s) with respect to the "X" axis, which is added to other independent claims 14 and 17. Further, besides the statement "claims 1-24 are now pending in this application" at the beginning of the remarks/arguments, there is no argument or discussion of independent claim 24 at all. Claim 24 limitations are still met by Kurata et al.

As claim 24 is understood (see objection to claim 24 above), the system of Kurata et al. still meets all limitations of claim 24. Kurata et al. discloses a system comprising a (first) set of slidable cursors (23 and 24) slidably moved in the Y-direction

(defined to be the main scanning direction) for defining positions (coordinates) of a scan area along the Y-direction. The X-direction is defined to be the subscanning direction of the apparatus in which the image reading unit (29) is moved during scanning. The set of slidable cursors are located on an axis that is parallel to the Y-direction. The set of cursors generate signals indicative of the coordinates corresponding to the first set. Note that the electronic circuit section (Fig. 5) generates signals or positional data (47, 61, etc.) with respect to the starting point and end point in the Y-direction (col. 3, line 39 – col. 4, line 47).

Further, a control interface is inherent in the electronic circuit section (Fig. 5) that initiates and controls a scan operation responsive to a scan signal received (from start button, col. 4, line 1+). The coordinate indicating signals (positional data) are communicated to the inherent control interface (col. 4, lines 1-61). Note that the plurality of cursors (23, 24) constituting a positioning apparatus for defining the scan area reads on the claimed positioning apparatus having a plurality of members for defining said scan area. The controller inherently determines whether the defined scan area is entirely within the scanable surface of the scanner or just a portion of the scanable surface.

9. Claims 11-13 are allowed.

10. Claims 2 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 7, 8, 16, and 19-21 would be allowable if rewritten to overcome the objection(s) set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. The following is an examiner's statement of reasons for allowance:

Claim 2 would be allowable because Kurata et al. does not disclose a generally L-shaped housing to which the first and second sets of slidable members are attached. Further, the slidable members or cursors of Kurata et al. is used with the standard scanner but do not belong to an apparatus having the generally L-shaped housing which is an external attachment to the standard scanner as claimed.

Claims 7 and 8 would be allowable because the first set or the second set of slidable members (cursors) of the obvious apparatus of Kurata et al. does not comprise four members having their relative positional limitations as claimed. Each set of slidable members or cursors of the obvious apparatus Kurata et al. has only two cursors.

Claim 9 would be allowable because Kurata et al. does not disclose a conductor as claimed.

Claim 11 and its dependent claims 12 and 13 are allowable over the prior art of record including Kurata et al. because the prior art does not disclose a combination of the claimed positioning apparatus and the control interface in addition to the scanner, the positioning apparatus having a plurality of coordinate specifying members for defining coordinates which together can specify a valid bounded scan area on the scan surface of the scanner, and generating signals that identify the coordinates for controlling the initiation and completion of a scan operation of the scanner. The apparatus of Kurata et al. does not disclose a "positional apparatus" and "control interface" as claimed in addition to the scanner. The scanner of Kurata et al. comprises the slidable cursors (23, 24). The slidable cursors alone are not considered to constitute a positioning apparatus since the cursors alone do not generate signals that identify the coordinates as claimed in claim 11.

Claims 16 and 19 would be allowable because Kurata et al. does not disclose the claimed steps related to "functionality" being enabled or not enabled since in the rejection of claims 15 and 18, the "functionality" is being enabled or disabled when the apparatus is turned on or turned off, respectively.

Claims 20 and 21 depend upon claim 19.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (703) 305-4867. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee
May 21, 2004